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FEB 3, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Viacom International, Inc.

v.

Kermit Komm, George Merritt and Darrell Niemann

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Opposition No. 98,994  
to application Serial No. 74/468,945  
filed on December 13, 1993

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Anthony Keats of Baker & Hostetler for Viacom International,  
Inc.

Kermit Komm, pro se.

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Before Sams, Seeherman and Quinn, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Viacom International Inc. has opposed the application  
of Kermit Komm, George Merritt and Darrel Niemann to  
register the mark MY-T-MOUSE THE SOFTWARE THAT MAKES YOUR  
MOUSE A MOUSE THAT TYPES! and design, as shown below,  
(hereafter referred to as "MY-T-MOUSE and design") for  
"computer software which enables the user to type by making

selections from an on-screen keyboard with a mouse."<sup>1</sup> The words THE SOFTWARE THAT MAKES YOUR MOUSE A MOUSE THAT TYPES have been disclaimed.



As grounds for opposition, opposer has alleged that since 1942 it and its predecessors have used the trademark MIGHTY MOUSE in association with a film series of animated cartoons for motion pictures and television; that these cartoons feature the character of a mouse known as MIGHTY MOUSE; that opposer is the owner of a number of registrations for the mark MIGHTY MOUSE and MIGHTY MOUSE and design for goods in Classes 5, 9, 14, 16, 25, 28 and 30<sup>2</sup>; that opposer has for many years been engaged in the business of licensing the use of the MIGHTY MOUSE mark and the MIGHTY MOUSE design on a wide variety of goods; that it engaged in active negotiations for the licensing of these marks for use in connection with the sale of computer products and accessories; and that applicants' applied-for mark MY-T-MOUSE and design, as used for applicants' identified goods,

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<sup>1</sup> Application Serial No. 74/468,945, filed December 13, 1993 and asserting first use and first use in commerce on October 11, 1993.

<sup>2</sup> Certain classes have been cancelled from some of these registrations, as will be discussed infra.

is likely, in view of the fame of the MIGHTY MOUSE cartoons and the MIGHTY MOUSE mark, to cause confusion or mistake or to deceive.<sup>3</sup>

Applicants have denied the essential allegations of the notice of opposition.<sup>4</sup>

The record includes the pleadings; the file of the opposed application; and the testimony, with exhibits, of opposer's witnesses Debra Petrasek, Tom Finn, Kermit Matthew Komm and Irwin Handelman, and of applicants' witness Kermit Matthew Komm. In addition, opposer has made of record by notice of reliance copies of its pleaded registrations for the word mark MIGHTY MOUSE for "film series of animated cartoons for motion pictures and television; comic magazines and coloring books; toy puzzles"<sup>5</sup> and for "watches; tee

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<sup>3</sup> Opposer also pleaded in its notice of opposition that applicants' mark would falsely suggest a connection with opposer. However, this issue was not briefed by opposer, and we therefore deem this Section 2(a) claim to have been waived.

<sup>4</sup> Applicants' response to the notice of opposition was not, as pointed out in the Board's action of January 19, 1996, couched in the normal language for an answer. The Board advised the parties that it would construe the response as an admission of the allegations of paragraphs 1-9 of the notice, and a denial of the allegations of paragraphs 10 and 11. Subsequently, on May 28, 1996, applicants, who were acting pro se, advised the Board that it had come to their attention that the word "admission" has certain legal implications, and sought leave to amend their answer. The Board indicated that it would construe this communication as a motion to amend the answer, and gave opposer time in which to file any objections to that motion. Opposer not having responded, and it being obvious from opposer's brief that it was not relying on the "admissions" of the earlier response, the Board hereby accepts applicants' amended answer.

<sup>5</sup> Registration No. 1,104,244, issued October 17, 1978; Section 8 affidavit accepted; Section 15 affidavit received.

shirts, sweatshirts"<sup>6</sup>; and for the design mark shown below for "film series of animated cartoons for motion pictures and television; sunglasses; watches; tee shirts, sweatshirts."<sup>7</sup>



The parties have fully briefed the case;<sup>8</sup> an oral hearing was not requested.

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<sup>6</sup> Registration No. 1,527,745, issued March 7, 1989; Section 8 affidavit accepted; Section 15 affidavit received. This registration was originally issued for goods in Classes 5, 14, 25 and 30; however, because no Section 8 affidavit was received for the goods in Classes 5 and 30, the registration was cancelled as to these classes.

<sup>7</sup> Registration No. 1,533,890, issued April 11, 1989; Section 8 affidavit accepted; Section 15 affidavit received. The registration was originally issued for goods in Classes 5, 9, 14, 16, 25, 28 and 30; however, as a result of opposer's failing to file a Section 8 affidavit for the goods in Classes 5, 16, 28 and 30, those classes were cancelled from the registration.

<sup>8</sup> In its brief opposer raised a question as to whether applicants have abandoned their rights in the mark because "there is nothing in the record to indicate that all three individual applicants control IMG's use of the mark." p. 8. This issue was neither pleaded nor tried. (In fact, opposer's brief identifies the only issue before us as being that of likelihood of confusion.) Thus, we have not considered the issue of abandonment.

We also note that with their brief applicants have submitted the diskette for the MY-T-MOUSE software product. This submission has not been considered in that it was not properly made of record during the testimony period.

In 1944 opposer's predecessor-in-interest, Terrytoons, gave the name MIGHTY MOUSE to a cartoon character it had created. This character was featured in a series of short animated film cartoons which were shown in theaters as part of movie presentations. In the early 1950s the rights in the MIGHTY MOUSE character were sold to CBS TV. Viacom International was spun off from CBS in 1971, and the rights in the Terrytoon properties went to Viacom.

CBS TV began airing the MIGHTY MOUSE cartoons in 1955 as a half-hour Saturday morning cartoon series. The initial MIGHTY MOUSE cartoon series ran on CBS for 12 years, with new cartoons being produced through 1961. This series was very successful, and achieved a 45.8 audience share, which means that 45.8% of the people watching television at the time the program aired were watching the MIGHTY MOUSE show. After the CBS series ended, the MIGHTY MOUSE cartoons were syndicated to individual television stations from the mid-60s until the early 1990s. The USA Network then obtained the rights to syndicate the series on its own cable network.

In 1979 new MIGHTY MOUSE cartoons were created for broadcast on network television, and 16 half-hour programs were aired on CBS TV under the title "The New Adventures of Mighty Mouse and Heckle & Jeckle." A third series, "Mighty Mouse: The New Adventures," was created in 1987 and broadcast on CBS to good critical reviews. This program was

broadcast on CBS until 1988. The cartoons have also been licensed for broadcast in many countries around the world.

According to Deborah Petrasek, opposer's vice president of domestic licensing, the words MIGHTY MOUSE and the mouse design have been licensed through the years for a variety of products, including toys, hats, apparel, novelty items and party goods.<sup>9</sup> Opposer made of record a jigsaw puzzle and coloring book, both bearing a 1977 copyright date, and a package of vitamins bearing a 1986 copyright date.

In 1994, Tom Finn, the director of business development for Viacom Consumer Products, was asked by senior management to put together a strategic plan in order to determine what rights in MIGHTY MOUSE were available to be exploited. In general, opposer exploits its properties by licensing the rights to third parties who then use the marks on merchandise. The merchandising, in addition to generating revenue, promotes the property and its visibility.

Mr. Finn testified that opposer has "looked at actually doing computer accessories, in terms of keyboards and screen savers and screen covers featuring the [MIGHTY MOUSE] characters." p. 26.

In addition, Ms. Petrasek testified that opposer had, as of the time of her testimony in June, 1996, entered into

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<sup>9</sup> Opposer did not provide any information as to the amount of sales, or the length of time during which these products were sold.

an agreement to license the MIGHTY MOUSE trademark for an interactive coloring disk. The product on which the mark is to be used is essentially software for what appears to be an electronic coloring book. She also testified that opposer was in the process of speaking to other potential licensees with respect to interactive-type products and computer peripherals.

Applicants use their MY-T-MOUSE and design mark for a software program operating in the Microsoft Windows environment. This software enables a user to operate the computer entirely from the mouse by creating a "keyboard" which floats on the computer screen so that users can point to letters or numbers with a mouse and click the character into the document on which they are working. The primary consumers for the product are physically disabled people who cannot use a regular keyboard. The software is also useful for those who wish to insert a limited number of characters into a document and do not want the distraction of looking from the monitor to the keyboard and back. Moreover, because different keyboard configurations may be superimposed with this software, it is useful for those working with a foreign alphabet, or for children and adults who are not familiar with the normal keyboard layout, and prefer the letters displayed in alphabetical order.

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Applicants were the programmers who developed the software for their predecessor-in-interest, Irwin Handelman; when Mr. Handelman decided to close his business he assigned all rights in the mark and the program to the current applicants in May 1995.

Irwin Handelman, his son Marc, and Kermit Komm, one of the current applicants, were involved in choosing the trademark. The primary words MY-T-MOUSE were meant to be an abbreviation for "My Typing Mouse," while the mouse design was based on the letter "T". The software program was in development for approximately two years, and a version was introduced in the fall of 1993 at the COMDEX computer show, where copies of it were distributed to the public. Since then, applicants have developed a line of software products using the phrase "My-T", e.g., MY-T-PEN, MY-T-TOUCH and MY-T-CALCULATOR. The MY-T-MOUSE program has been promoted through press releases, direct mail, promotional literature, trade shows, and in periodicals such as "Windows Magazine" and "Assistive Technology", a newspaper directed to the physically challenged. It was also featured in an article published in "Info World," and on a PBS television program called "Computer Chronicles," which shows new computer products. The program is available through such stores as Egghead, Micro Center and Software City. Sales of the MY-T-MOUSE software product have thus far been relatively small,



Mr. Handelman testifying that sales amounted to approximately \$30,000 and 5,000 units, and Mr. Komm testifying to sales in 1995 of approximately \$1600. Applicants are currently expanding their sales to various European countries. The suggested retail prices for the various programs range from \$30 to \$50.

Inasmuch as opposer has made its pleaded registrations of record, priority is not an issue with respect to the animated cartoons, comic magazines, coloring books, toy puzzles, watches, tee shirts, sweatshirts and sunglasses identified in those registrations. **King Candy Co. v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record shows that opposer began using the mark MIGHTY MOUSE for vitamins prior to applicants' adoption of their mark.

This brings us to the issue of likelihood of confusion. After considering all the factors involved in a determination of likelihood of confusion, as set out in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), which are of record in this case, we find that opposer has not proved that confusion is likely to occur from applicant's use of its applied-for mark for its identified goods.

Turning first to a consideration of the goods, we find that the goods for which opposer has priority as a result of

its registrations or its evidence of prior use--goods such as animated cartoons, clothing, toys, coloring and comic books, vitamins and sunglasses--are very different from the "computer software which enables the user to type by making selections from an on-screen keyboard with a mouse" identified in applicants' application.

Nor has opposer shown that such software is within the natural scope of expansion for the use of opposer's mark. Opposer has presented very limited testimony in that regard. Specifically, Ms. Petrasek has stated that opposer has executed a deal to license its MIGHTY MOUSE mark for an interactive coloring disk<sup>10</sup> and "is in the process of also speaking to several other potential licensees for other interactive type products, including interactive adventures with one particular software manufacturer, interactive comic books with another...." She also made the rather vague statement that opposer is "in conversations with manufacturers of some peripherals items, such as actually a mouse that - an actual mouse that you use in your computer, but it would be molded in the shape of Mighty Mouse." Petrasek, p. 21.

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<sup>10</sup> There is no evidence that this product had been produced as of the time the testimony was taken. On the contrary, Ms. Petrasek identified as an exhibit a "Gumby and Friends" coloring disk which she stated was an example of the way opposer intended to use the MIGHTY MOUSE trademark.

Ms. Petrasek also made some very general comments that its other merchandising marks, especially Star Trek, have been licensed in the "interactive electronics area." These comments, in their entirety, follow:

We've done a variety of software products and gaming products, hardware accessories, computer accessories, including molded keyboards, mice, disc caddies--that's on the hardware side--and also in the electronics area, like molded telephones, et cetera, and then on the software side not only for Star Trek but for properties like Top Gun, Mission Impossible, Addams Family. We've done several different kind of products in the interactive and electronics area.  
Petrasek, p. 25.

Opposer did not give any details about these products, nor did it make of record any exhibits showing the manner in which the marks are used on the goods. Aside from the coloring disk, opposer did not indicate specifically what the software is used for.

Opposer has failed to prove that applicants' specialized software is the type of product for which a merchandising mark such as opposer's would be used. Opposer licenses its MIGHTY MOUSE marks, and its other merchandising marks, for a variety of products where the product is bought because of the mark. Thus, a consumer may purchase a tee shirt because it bears the name and picture of MIGHTY MOUSE, or a coloring book because it has pictures of the cartoon character. The merchandising, as Mr. Finn testified, promotes the trademark and its visibility.

Applicants' software, on the other hand, is for a very specialized purpose, i.e., to create a floating keyboard on the computer screen so that users can "type" by clicking with the mouse rather than by typing on a keyboard. The users of this software are also "specialized," in that they are all people who do not want to use a traditional typing keyboard. They include the handicapped, those who want to use a foreign alphabet or foreign alphabet keyboard arrangement, and those who do not want to shift their view between the screen and the keyboard. Applicants' software program is very different from the interactive coloring books and interactive games, or the screen savers and mouse pads on which opposer intends to expand the use of its mark.

The mere fact that computer accessories and computer toys and games involve the use of computers or software, and that applicants' goods are also computer software, does not, in and of itself, demonstrate that the computer software on which applicants use their mark is within the natural scope of expansion of the use of opposer's mark. As we have said in the context of determining whether products are related, "Given the ubiquitous use of computers in all aspects of business in the United States today, this Board and its reviewing Court have rejected the view that a relationship exists between goods and services simply because each involves the use of computers." **Electronic Data Systems**

**Corp. v. EDSA Micro Corp.**, 23 USPQ2d 1460, 1463 (TTAB 1992).

See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990);

*Information Resources Inc. v. X\*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988).

Opposer has not presented evidence showing that software of the type sold by applicants is the kind of product on which a character or merchandising mark would be used. Thus, there is no basis to conclude that consumers would assume that applicants' goods were licensed or approved by opposer.

This determination is further buttressed by the differences in the marks. While we agree with opposer that MY-T-MOUSE is the dominant part of applicants' mark, and may be pronounced in the same way as MIGHTY MOUSE, there are significant differences in the appearances of the marks, specifically the spellings of MIGHTY and MY-T, and the appearances of the "realistic" cartoon action hero mouse and the abstract mouse face formed from the letter "T". Because merchandising marks are exploited for their connection to the exploited property, consumers would not expect that applicants' goods bearing the mark MY-T-MOUSE with an abstract mouse design emanate from or are sponsored by opposer.

Moreover, the marks have different connotations, in that applicants' mark is actually used in connection with the computer peripheral known as a "mouse," and this meaning is further emphasized by the informational language in the mark, THE SOFTWARE THAT MAKES YOUR MOUSE A MOUSE THAT TYPES. Thus, it is the connotation of the computer accessory, rather than of the cartoon animal associated with opposer's mark, that consumers will perceive.

With respect to the aural similarity of the marks, we are not persuaded by applicants' argument that consumers will necessarily pronounce their mark with the accent on the "T", and thereby differentiate the mark from opposer's. However, consumers will see applicants' mark when they purchase the goods, and will therefore readily note that the MY-T-MOUSE and design mark is very different from MIGHTY MOUSE. Thus, although in some cases phonetic similarity alone may be a sufficient basis for finding marks to be confusingly similar, in this case we do not think that it is.

It must be remembered that applicants' software program has a relatively sophisticated purpose. It is not likely to be casually purchased, and therefore purchasers will readily note the differences between applicants' mark and the mark MIGHTY MOUSE. We would also point out that, to the extent

that children would use this product, they are not likely to be the purchasers for it.

We have taken into consideration opposer's argument regarding the fame of its mark. Fame, of course, is a significant factor in the determination of likelihood of confusion, and can play a dominant role in cases featuring a famous or strong mark. **Kenner Parker Toys Inc. v. Rose Art Industries Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). However, MIGHTY MOUSE is not a famous mark in the legal sense that other marks have been found to be famous. The evidence shows that MIGHTY MOUSE achieved its fame as a cartoon character of the 1940s, '50s and early '60s. Opposer has provided little evidence of the extent of the use of the mark in the United States since that time. For example, although there was testimony that the mark was used on toy puzzles and vitamins, there was no evidence as to the amount of sales of these products. Ms. Petrasek gave only the copyright date shown on the labels of the packaging. Nor did opposer provide evidence of how often, or where, the MIGHTY MOUSE cartoon programs were shown when they were in syndication. As opposer itself has recognized, MIGHTY MOUSE is one of its nostalgic television properties, and its appeal is to adults because it is they who remember the first television series.

We recognize that applicants, in their brief, made the statement that "opposer has provided proof of their famous mark." p. 6. However, Mr. Komm, who is acting on behalf of himself and the other two applicants, is not an attorney, and we cannot view this statement as an admission of fame in the legal sense. We also note that in the paragraph preceding this statement applicants referred to the mark as "an animated cartoon character used in entertainment."

We acknowledge that applicants' mark MY-T-MOUSE and design might bring to mind the cartoon MIGHTY MOUSE. However, this does not necessarily mean that consumers will be confused into believing that the two marks indicate the same source of origin. See **Jacobs v. International Multifoods Corp.**, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) (the fact that one mark may bring another to mind does not in itself establish likelihood of confusion as to source). See also, **Original Appalachian Artworks Inc. v. Streeter**, 3 USPQ2d 1717 (TTAB 1987) As the Court stated in **University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.**, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983):

likely \*\*\* to cause confusion means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is



contrary to principles of trademark law and to concept embodied in 15 USC § 1052(d).

Thus, even in the case of a famous mark (and, as we have stated, on this record MIGHTY MOUSE does not rise to the level of a famous mark), the mere fact that the junior user's mark may remind the public of the famous mark does not mean that the use of the junior mark is likely to cause confusion. For the reasons given above, we find that consumers will distinguish between the parties' marks, and are not likely to believe that applicants' identified software, sold under the MY-T-MOUSE and design mark, emanates from or is sponsored by the same source as the MIGHTY MOUSE cartoon character.

In reaching this conclusion, we recognize that applicants' predecessor was aware of opposer's MIGHTY MOUSE character when he adopted his mark. Mr. Handelman clearly remembered the MIGHTY MOUSE cartoons which were shown as movie shorts during the 1940s. However, it is equally clear that, in adopting the mark, he did not intend to associate his product with opposer, or trade on opposer's good will. Mr. Handelman said he had neither heard of nor seen Mighty Mouse for 35 or 40 years, that he knew of the cartoon character when he was a child but that it had then disappeared. At most, we can only conclude that he was aware of the mark MIGHTY MOUSE, but he believed that it had not been used for over 30 years.

**Opposition No. 98,994**

Decision: The opposition is dismissed.

J. D. Sams

E. J. Seeherman

T. J. Quinn  
Administrative Trademark Judges  
Trademark Trial and Appeal Board